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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,296	11/30/2000	Henry N. Holtzman	PRT-007	4729

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GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881		

EXAMINER	
HAMILTON, LALITA M	

ART UNIT	PAPER NUMBER
3691	

MAIL DATE	DELIVERY MODE
07/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/726,296

Applicant(s)

HOLTZMAN ET AL.

Examiner

Lalita M. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

On October 6, 2006, an Office Action was sent to the Applicant rejecting claims 1-23. On April 5, 2007, the Applicant responded by amending claims 1, 13, 14, and 17.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-13, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Sehr (6,085,976).

Sehr discloses a method and corresponding system for multi-applicant cards comprising completing a form presented to a user in a computer application program, the form requesting information about the user, identifying a form presented to a user in a computer application program, the form requesting information about the user, receiving by a card reader a magnetic stripe card comprising card information, generating a unique identifier based on the card information, associating the unique identifier with the user, obtaining previously stored user information based on the identifier, matching elements of user information with elements of information about the user requested in the form, and completing the form request for information with the matching elements of user information (col.6, lines 15-51 and col.38, lines 25-67); single

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user action comprising directing a magnetic stripe card through a magnetic stripe reader (col.6, lines 15-51 and col.38, lines 25-67); form identified by parsing the HTML code of a web page (col.5, lines 1-3); the unique identifier is generated by providing the card information as input to a one-way function (col.6, lines 15-51 and col.38, lines 25-67); unique identifier is generated by combining elements of card information, and providing the combined card information as input to a one-way function (col.6, lines 15-51 and col.38, lines 25-67); the user information is at least a portion of a user profile obtained from a server accessible via the internet (col.5, lines 1-3; col.6, lines 15-51; and col.38, lines 25-67); the user information is obtained from a local database (col.6, lines 15-51 and col.38, lines 25-67); elements of user information are matched with elements of information about the user requested in the form by using a field mapping script (col.6, lines 15-51 and col.38, lines 25-67); completing the request for information with at least one element of card information and with matching elements of user information (col.6, lines 15-51 and col.38, lines 25-67); elements of user information are matched with elements of information about the user requested in the form by matching form field names with elements of user information (col.6, lines 15-51 and col.38, lines 25-67); identifying a form in a web page downloaded from a merchant web server presented to a user in a web browser and associating by an information server separate from the merchant web server the unique identifier with the user, obtaining by the merchant web server directly from the information server user information based on the identifier and completing by the merchant web server the form request by matching elements of user information with the requested information (col.2, lines 40-53; col.6, lines 15-51; and

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col.38, lines 25-67); completing a form presented to a user in a computer application program, the form requesting information about the user, identifying a form presented to a user in a computer application program, the form requesting information about the user, receiving by a card reader a magnetic stripe card comprising a unique identifier, associating the unique identifier with the user, obtaining previously stored user information based on the identifier matching elements of user information with elements of information about the user requested in the form, and completing the form request for information with the matching elements of user information (col.6, lines 15-51 and col.38, lines 25-67); and a display for displaying a form presented to a user of a computer application program, the form requesting information about the user, a token reader for receiving a token presented by the user, the token comprising a magnetic stripe card or an RFID tag, the token comprising an identifier, a dispatch module for associating the identifier with the user, obtaining previously stored user information based on the identifier, matching elements of user information with elements of information about the user requested in the form, and completing the form request for information with the matching elements of user information (col.6, lines 15-51 and col.38, lines 25-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4 and 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sehr in view of Martino (5,987,103).

Sehr discloses the invention substantially as claimed; however, Sehr does not disclose the magnetic stripe card is received by an RFID token reader. Martino teaches a method and corresponding system for transaction entry comprising the magnetic stripe card is received by an RFID token reader (col.1, line 64 to col.2, line 20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the magnetic stripe card is received by an RFID token reader, as suggested by Martino into the invention disclosed by Sehr, to provide an alternative use of using the swipe card to input information.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all of the claimed invention,

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as well as the context of the passage as taught by the prior arts or disclosed by the Examiner.

Response to Arguments

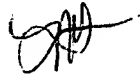
Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


LALITA M. HAMILTON
PRIMARY EXAMINER